

EXAMINER'S ISSUE CHECKLIST

When passing an application to issue, each of the following items should be checked:

1. CLAIMS

- Single sentence, starting with a capital letter and ending with a period (beware of claims ending with chemical structure and no period).
- Claim text should not be missing or contain duplicate or additional text.
- Amendments to claims should be clear and not misplaced.
- Make sure that no claim is missing-All claims are either canceled or allowed and no claims indicated as existing in the case are missing.
- Claim numbering:
 - If needed, Examiner should renumber both the independent and dependent claims, properly.
 - No two claims are numbered the same.
 - Renumbered claims should agree with Index of Claims box
- Dependent claims:
 - No claim depends from the wrong claim or a higher-numbered claim.
 - Dependent claims narrow the scope of the claim from which they depend.
 - No improper multiple dependent claims
 - All claims refer back to the correct claim as renumbered.
- All changes to claims made by examiner (except renumbering) made by formal examiner's amendment.

2. SPECIFICATION

- Abstract:
 - Abstract is present, and gives an adequate and clear statement of the disclosed invention (MPEP 608.01(b)).
 - Abstract is on a separate page, following claims.
 - No more than 150 words.
 - Single paragraph -no legal phraseology such as “said” or “means”.
- Continuing data is mentioned in first paragraph, including §371 data, if any, and agrees with the Continuing Data on Bibliographic Data Sheet. **NOTE:** If application data sheet (ADS) has been filed, continuing data do NOT need to be mentioned in first paragraph; however, the Bibliographic Data Sheet (BDS) must agree with the most recent ADS-correct BDS if necessary.

SPECIFICATION, continued

- U.S. applications referred to by Attorney Docket Number or left blank (“U.S. Application No. _____”) should be changed to U.S. Serial Numbers (or cancelled) by a formal examiner's amendment.
- Check for Brief Description of Drawings of each figure. If a figure contains several parts, for example, figure 1A, 1B, and 1C, the figure may be described as figure 1. If only figure 1A is described in the brief description, the examiner should object to the brief description,

and require applicant to either add a brief description of figure 1B and 1C or describe the figure as “figure 1.” See MPEP 608.01(f)

- Recheck Brief Summary & Description to see if in harmony with the claims, amend as necessary by formal examiner's amendment (MPEP 1302.01).
- No blanks or missing text (e.g. “Serial Number ____”).
- No amendments are misplaced or unclear.
- Erase all pencil marks and notations (Reminder: pencil marks not permitted in file).
- No unclear or missing words because of HOLES at top of page or poor copy quality.
- No missing pages or page numbers, no duplicate pages, page numbers are consecutive.
- Examples, tables, etc. numbered/lettered consecutively.
- Text and tables/charts legible.
- No non-initialed alterations.
- Minor, obvious errors in spelling, grammar, punctuation corrected in red ink by Examiner; initial and date in left margin.
- CD-ROM submissions (e.g. large tables, computer programs) are in compliance with MPEP 608.05.

3. OATH OR DECLARATION

- Names of applicants on file wrapper/ bibliographic data sheet same as in oath/declaration.
- Full given name for each applicant (MPEP 605.04(b)).
- Signature, Mailing Address (and Residence if an inventor lives at a location which is different from where the inventor customarily receives mail) and Citizenship for each inventor. (Mailing address (and residence, if necessary) may be found on Application Data Sheet, see MPEP 601.05).
Citizenship MUST appear on the oath/dec even if it appears on the ADS.
- Any alterations initialed and dated.
- Foreign priority includes country, serial number and filing date (check against file wrapper/bibliographic data sheet). (May be found on Application Data Sheet, see MPEP 601.05).
- Continuing data, if any, is completed and agrees with first paragraph of specification and bibliographic data sheet. (May be found on Application Data Sheet, see MPEP 601.05. If on Application Data Sheet, does not need to be repeated at first paragraph of specification, will be printed automatically).

4. APPLICATION DATA SHEET

- If more than one Application Data Sheet is present, only the most recent one is considered.

5. PTO-1449 INFORMATION DISCLOSURE STATEMENT (MPEP 609)

- All PTO-1449s filed have been considered.
- All IDS Flags Cleared in Palm
- U.S. Patents-identified by patent number, patent date (Month-Year), and patentees.
- Foreign published applications and patents-identified by document number, publication date (Month-Year) and country or office.

- Printed publications-identified by author (if any), title, publication date (Month-Year), volume and issue number (if known), and pages relied on.
- Examiner should initial all citations considered.
- Examiner should draw a line through each citation not considered.
- For each US patent considered, Examiner should insert the relevant classification or draw a line in the space provided for classification information.
- Sign and date each page.
- No duplicate references- cross out any subsequent occurrences of a previously cited reference (including on PTO-892).

6. PTO-892 NOTICE OF REFERENCES CITED (MPEP 707.05)

- PTO-892 is present – if the Examiner cited no references, write “NONE” across the body of the form.
- U.S. Patents-identified by patent number, patent date (Month-Year), and patentees. If class/subclass not provided, line through appropriate boxes.
- Foreign published applications and patents-identified by document number, publication date (Month-Year) and country or office. If classification not provided, line through appropriate boxes.
- Printed publications-identified by author (if any), title, publication date (Month-Year), volume and issue number (if known), and pages relied on.

7. DRAWINGS

- Figure selected for printing must be consistent with claim selected for printing, and must be referred to in the abstract. If no figure is to be printed, write “none” in the appropriate box
- Do not select a figure labeled as “prior art” for printing.
- If color photographs or drawings are present, check MPEP 608.02 for requirements.

8. SEARCH NOTES

- Update and complete Searched Box, Searched Notes Box and Interference Searched Box. Must Include EAST/WEST Search History Printout.
- Search Notes Box:
 - Parent files checked
 - Consultations with other examiners, practice specialists, SPE’s, recorded.
 - Database searches recorded, with “printout attached” indicated, or search strategy set forth; specific vendors and files listed (e.g. Dialog, files 5, 55).
- Interference Searched Box:
 - Lists both original class and subclass and all cross-referenced classes and subclasses.
 - Enter Final claim numbers and indicate allowed status in Index of Claims.

9. IFW Issue Classification Form

- Assistant Examiner and Primary Examiner spaces should be completed.
- Update FINAL classification:

- Complete classification cross-references.
- Complete INTERNATIONAL CLASSIFICATION.
- TITLE-should reflect claimed invention-Rewrite if necessary (bleachable red ink, initial and date).
- Print claim should be the most comprehensive independent claim that conveys the nature of the invention. If dependent claim is printed, independent claim from which it depends must also be printed.
- Fill in numbers of Figures and Figure Sheets. Count sub-figures (e.g., 1B, 1C) as separate figures.
- Terminal Disclaimer box should be checked, if present.

10. BIBLIOGRAPHIC DATA SHEET

- Update and complete Continuing Data including identifying any PCT applications and filing date and if published, its date and identifying number. Continuing data should agree with first paragraph of specification or Application Data Sheet (if present). Note: Certain errors or omissions of preprinted data must be submitted to Application Branch to correct Palm database. (MPEP 202.02).
- Recheck Foreign-PCT application with oath or declaration or Application Data Sheet, if present. If in error, correct in black ink (See MPEP 202.03).
- Foreign priority claim should be verified and acknowledged.
- Check to see if certified copy of priority document is present and acknowledged.

11. MISCELLANEOUS

- Contents of file wrapper should be checked to ensure that all amendments were timely filed and the application is not abandoned (all necessary extensions of time have been purchased or authorized).
- All references, other than U.S. patents and U.S. patent application publications, cited during the prosecution should be attached to the file. Copies of U.S. patents and U.S. patent application publications are left in the file (for possible review by Quality Review), but are not clipped to the file.
- Check to ensure the substance of all interviews is of record in the file.
- In cases filed under 35 U.S.C. § 371, check to ensure that form PCT/DO/EO/903 is present authorizing the filing under 371 and stating the priority dates. A photocopy of the ribboned priority document must also be in the file.